

REMARKS

In the Office Action identified above, the Examiner objected to claims 1 and 6 due to informalities; rejected claims 1, 4, 10, 15, 17, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Tsukamoto et al. (U.S. Patent No. 6,559,964) in view of Ota (U.S. Patent No. 6,128,102); rejected claims 2, 3, 5, 7, 9, 11-14, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Tsukamoto et al. and Ota, and further in view of Unno (U.S. Patent No. 6,437,875); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Tsukamoto et al. and Ota, and further in view of Okamura et al. (U.S. Patent No. 6,266,162); and objected to claim 6 as being dependent upon a rejected base claim, but stated that claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Based on the following reasoning, Applicants respectfully traverse the Examiner's objections and rejections under 35 U.S.C. § 103(a).

Applicants have amended claims 1 and 19 to more appropriately define their invention, and have cancelled claim 6. Applicants have also added new claims 20 and 21. Claims 1-5 and 7-21 remain pending.

I. Claim Objections

The Examiner objected to claims 1 and 6 due to informalities. Applicants have amended claim 1 as suggested by the Examiner and canceled claim 6 without prejudice or disclaimer. Therefore, Applicants request the Examiner to withdraw the objections to claims 1 and 6.

II. The Rejection of Claims 1, 4, 10, 15, 17, and 19 Under 35 U.S.C. § 103.

Claims 1, 4, 10, 15, 17, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsukamoto et al. in view of Ota. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 1 recites "[a] document input system," including *inter alia* "storage means for storing the document image inputted by the at least one digital copier and the information relating to the document image, wherein the at least one digital copier generates a title for the document image based on priorities assigned, by the at least one digital copier, to the information relating to the document image inputted." The Examiner admits that Tsukamoto et al. fails to teach or suggest that "the digital copier generates a title for the document image based on the information relating to the document image inputted." (OA at 4). Therefore, Tsukamoto et al. certainly fails to teach or suggest "wherein the at least one digital copier generates a title for the document image based on priorities assigned by

the at least one digital copier to the information relating to the document image inputted,” as recited in independent claim 1. Furthermore, Ota does not cure the deficiencies of Tsukamoto et al. In the passages cited by the Examiner, Ota discloses “retrieving an image file in a case where a title or keyword is inputted” by a user at a digital copier. (Col. 6, lines 45-51). However, Ota fails to teach or suggest “wherein the at least one digital copier generates a title for the document image based on priorities assigned by the at least one digital copier to the information relating to the document image inputted,” as recited in independent claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claim 1, no *prima facie* case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 103 as being obvious from Tsukamoto et al. in view of Ota.

Claims 4, 10, 15, and 17 depend from claim 1. As explained, claim 1 recites elements not disclosed by Tsukamoto et al. and Ota. Accordingly, claims 4, 10, 15, and 17 are allowable over Tsukamoto et al. and Ota for at least the same reasons as claim 1. Applicants, therefore, respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Independent claim 19 although of different scope, recites elements similar to that discussed above with regard to claim 1. Applicants, therefore, request the Examiner to withdraw the rejection of claim 19 for at least the same reasons discussed above with respect to claim 1.

III. The Rejection of Claims 2, 3, 5, 7-9, 11-14, 16, and 18 Under 35 U.S.C. § 103).

Claims 2, 3, 5, 7-9, 11-14, 16, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsukamoto et al. and Ota and further in view of Unno or Okamura et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. Claims 2, 3, 5, 7-9, 11-14, 16, and 18 depend from claim 1 and, therefore, include all the elements of claim 1. As explained, claim 1 recites elements not disclosed by Tsukamoto et al. and Ota. Furthermore, Applicants submit that Unno and Okamura et al. do not cure this deficiency. That is, Unno and Okamura et al. also fail to teach “storage means for storing the document image inputted by the at least one digital copier and the information relating to the document image, wherein the at least one digital copier generates a title for the document image based on priorities assigned, by the at least one digital copier, to the information relating to the document image inputted,” as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach or suggest each and every element required by claims 2, 3, 5, 7-9, 11-14, 16, and 18, no *prima facie* case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 2, 3, 5, 7-9, 11-14, 16, and 18 under 35 U.S.C. § 103 as being obvious from Tsukamoto et al. and Ota and further in view of Unno or Okamura et al.

IV. New Claims 20 and 21.

The Examiner objected to claim 6 as being dependent upon a rejected base claim, but stated that claim 6 would be allowable if rewritten in independent form including all of

the limitations of the base claim and any intervening claims. Applicants acknowledge with appreciation the Examiner's indication that claim 6 includes allowable subject matter. Applicants have added new independent claim 20 to include the elements of claim 6, base claim 1 and intervening claims 2, 3, and 5. Accordingly, claim 20 is allowable. Claim 21 depends from claim 20 and, therefore, requires all of the elements of claim 20 and is also allowable. As such, Applicants request the Examiner to allow claims 20 and 21.

V. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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